

Application No.: 10/706,300  
Filing Date: November 12, 2003

**REMARKS**

This Amendment is responsive to the Examiner's Office Action of March 17, 2009. By way of summary, Claims 1-6 and 46-72 were pending in the application. Applicants have hereby amended Claims 48, 67 and 70, canceled Claims 1-6, 46, 47, 52-57 and 69, and added new Claim 73. Thus, Claims 48-51, 58-68 and 70-73 are presently pending in this application. Reconsideration of the application in view of the foregoing amendments and following remarks is respectfully requested.

As a preliminary matter, Applicants would like thank the Examiner Deak for the courteous telephonic interview extended to Applicants' attorney of record, William H. Shreve, on June 4, 2009.

**Claims 48-51, 58-68 and 70-72 and are Patentable Over the Applied Combination**

The Examiner rejected Claims 1, 2, 4, 5, 46-49, 52-57 and 70-72 under 35 U.S.C. § 103(a) as being obvious in view of the combination of U.S. Patent No. 6,450,984 B1 to Lynch et al. ("Lynch") and U.S. Patent Appl. Publ. No. 2005/0119737 A1 to Bene et al. ("Bene"); Claims 3 and 6 under 35 U.S.C. § 103(a) as being obvious in view of the combination Lynch, Bene and U.S. Patent No. 7,033,603 B2 to Nelson et al.; and Claims 50, 51 and 58-69 under 35 U.S.C. § 103(a) as being obvious in view of the combination Lynch, Bene and U.S. Patent No. 4,521,210 to Wong.

Applicants respectfully traverse these rejections and the Examiner's characterization of the cited references on the bases set forth below.

In this case, to advance prosecution, Applicants have amended Claims 67 and 70 and canceled apparatus Claims 1-6, 46, 47 and 52-57, as shown above and in view of the June 4, 2009 interview. Dependent Claim 68 has been canceled in view of the amendment to independent Claim 67. Claim 48 has been amended for consistency and not for purposes of patentability. Applicants reserve the right to pursue any of the prior versions of the claims in one or more continuing applications and/or at a later date.

Lynch is directed to a shunt device and method for treating glaucoma. Lynch teaches that the implant distal (outlet) end resides and remains in Schlemm's canal, and never enters into the anterior chamber of the eye.

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Bene is directed to an ocular implant and methods for making and using same. Bene teaches that the implant distal (outlet) end resides and remains outside the eye on a corneal and/or scleral surface, and never enters into the anterior chamber of the eye.

Wong is directed to an eye implant for relieving glaucoma, and device and method for use herewith. Wong teaches that the implant distal (outlet) end resides and remains in the suprachoroidal space, and never enters into the anterior chamber of the eye.

There is no teaching or suggestion, in Lynch, Bene and Wong, individually or collectively, of introducing or inserting the implant into the anterior chamber "such that at least a distal end of the implant is temporarily in the anterior chamber" as required by the subject claims.

Accordingly, and as discussed in more detail below, the Examiner's applied combinations fail to teach or suggest one or more limitations of the pending claims.

Turning now to the specific claims, independent Claim 48 is directed to a method of treating an ocular disorder and recites, *inter alia* (emphasis added):

**introducing an implant comprising a therapeutic drug into  
an anterior chamber of an eye such that at least a distal end of  
the implant is temporarily in the anterior chamber.**

As discussed above, at least this step is not taught or suggested by either Lynch or Bene. Accordingly, Applicants submit that Claim 48 is patentable over the applied combination for at least this reason.

Claims 49-51 depend from Claim 48 and are patentable for at least the same reason that Claim 48 is patentable, and because of the unique combination of limitations recited therein. Moreover, these claims define over the prior art, since the combination of limitations recited therein are not found in an individual prior art reference, or rendered obvious by a combination of prior art references.

Accordingly, Applicants respectfully submit that Claims 48-51 are in condition for allowance.

Independent Claim 58 is directed to a method of treating an ocular disorder and recites, *inter alia* (emphasis added):

**introducing an implant comprising a therapeutic drug into  
an anterior chamber of an eye such that at least a distal end of  
the implant is temporarily in the anterior chamber.**

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As discussed above, at least this step is not taught or suggested by either Lynch, Bene or Wong. Accordingly, Applicants submit that Claim 58 is patentable over the applied combination for at least this reason.

Claims 59-63 depend from Claim 58 and are patentable for at least the same reason that Claim 58 is patentable, and because of the unique combination of limitations recited therein. Moreover, these claims define over the prior art, since the combination of limitations recited therein are not found in an individual prior art reference, or rendered obvious by a combination of prior art references.

Accordingly, Applicants respectfully submit that Claims 58-63 are in condition for allowance.

Independent Claim 64 is directed to a method of treating an ocular disorder and recites, *inter alia* (emphasis added):

**inserting an implant through the incision into an anterior chamber of the eye such that at least a distal end of the implant is temporarily in the anterior chamber**, the implant comprising a therapeutic drug.

As discussed above, at least this step is not taught or suggested by either Lynch, Bene or Wong. Accordingly, Applicants submit that Claim 64 is patentable over the applied combination for at least this reason.

Claims 65 and 66 depend from Claim 64 and are patentable for at least the same reason that Claim 64 is patentable, and because of the unique combination of limitations recited therein. Moreover, these claims define over the prior art, since the combination of limitations recited therein are not found in an individual prior art reference, or rendered obvious by a combination of prior art references.

Accordingly, Applicants respectfully submit that Claims 64-66 are in condition for allowance.

Independent Claim 67 is directed to a method of treating an ocular disorder and recites, *inter alia* (emphasis added):

**introducing an implant into an anterior chamber of an eye such that at least a distal end of the implant is temporarily in the anterior chamber**.

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As discussed above, at least this step is not taught or suggested by either Lynch, Bene or Wong. Accordingly, Applicants submit that Claim 67 is patentable over the applied combination for at least this reason.

Claim 68 depends from Claim 67 and is patentable for at least the same reason that Claim 67 is patentable, and because of the unique combination of limitations recited therein. Moreover, these claims define over the prior art, since the combination of limitations recited therein are not found in an individual prior art reference, or rendered obvious by a combination of prior art references.

Accordingly, Applicants respectfully submit that Claims 67 and 68 are in condition for allowance.

Independent Claim 70 is directed to a method of treating an ocular disorder and recites, *inter alia* (emphasis added):

**introducing the implant into an anterior chamber of an eye such that at least a distal end of the implant is temporarily in the anterior chamber.**

As discussed above, at least this step is not taught or suggested by either Lynch or Bene. Accordingly, Applicants submit that Claim 70 is patentable over the applied combination for at least this reason.

Claims 71 and 72 depend from Claim 70 and are patentable for at least the same reason that Claim 70 is patentable, and because of the unique combination of limitations recited therein. Moreover, these claims define over the prior art, since the combination of limitations recited therein are not found in an individual prior art reference, or rendered obvious by a combination of prior art references.

Accordingly, Applicants respectfully submit that Claims 70-72 are in condition for allowance.

#### **New Claim 73 Defines Over the Prior Art**

Applicants have added new Claim 73 to vary further the scope of protection. This claim is supported by the Application as originally filed, and no new matter has been introduced. (Applicants would like to point out that this claim is entitled to a priority date of April 14, 2000.)

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Independent Claim 73 is directed to a method of treating an ocular disorder and recites, *inter alia* (emphasis added):

**introducing the implant into an anterior chamber of an eye such that at least a distal end of the implant is temporarily in the anterior chamber;**

**inserting at least a portion of the implant into eye tissue at an implantation site without penetrating through a cornea or a sclera of the eye.**

As discussed above, at least the “introducing” step is not taught or suggested by the applied references, individually or collectively. Additionally, the applied references teach specifically that the implant penetrates through the cornea or sclera during implantation in eye tissue at an implantation location or site, the antithesis of the inserting-without-penetrating-through limitation. Moreover, Claim 73 defines over the prior art, since the combination of limitations recited therein are not found in an individual prior art reference, or rendered obvious by a combination of prior art references.

Accordingly, Applicants respectfully submit that Claim 73 is in condition for allowance.

#### **Petition to Correct Inventorship**

A petition to correct invention under 37 C.F.R. § 1.48(a) was filed in this patent application on May 1, 2008. Specifically, the petition was a request to add Olav B. Bergheim and Morteza Gharib as joint inventors in the patent application.

Primary Examiner Deak’s consideration and approval of this petition is most earnestly solicited.

#### **No Disclaimers or Disavowals**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not

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reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

**Co-Pending Applications of Assignee**

Applicants wish to draw the Examiner's attention to the following co-pending applications of the present application's assignee. While Applicants have directed the claims of the above-captioned application toward subject matter distinct from that claimed in the other co-pending applications, similarities do exist between the subject matter recited by the claims of the other applications and the claims of the present case. See, for example, the claims of co-pending application serial no. 10/889,254, which currently stand rejected, and Claim 70 and newly added Claim 73 of the present application.

Serial Number	Title	Filed	Attorney Docket No.
10/889,254	OCULAR IMPLANT WITH ANCHOR AND THERAPEUTIC AGENT	July 12, 2004	GLAUKO.1C2C3
12/366,242	IMPLANT AND METHODS THEREOF FOR TREATMENT OF OCULAR DISORDERS	February 5, 2009	GLAUKO.1C2C3DV1
11/124,440	METHOD OF DELIVERING AN IMPLANT FOR TREATING AN OCULAR DISORDER	May 6, 2005	GLAUKO.1C4C2
11/841,967	THERAPEUTIC SHUNT DEVICE AND METHOD FOR TREATING GLAUCOMA	August 20, 2007	GLAUKO.1C4C10
12/366,565	OCULAR IMPLANT WITH ANCHOR AND METHODS THEREOF	February 5, 2009	GLAUKO.1C4C11
12/437,482	METHOD OF DELIVERING AN IMPLANT FOR TREATING AN OCULAR DISORDER	May 7, 2009	GLAUKO.1C4C12
12/354,610	OCULAR IMPLANT WITH ANCHORS AND METHODS THEREOF	January 15, 2009	GLAUKO.1CP1C1CC
10/950,175	IMPLANT WITH INTRAOCCULAR PRESSURE SENSOR FOR GLAUCOMA TREATMENT	September 24, 2004	GLAUKO.5C1CP1

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Serial Number	Title	Filed	Attorney Docket No.
11/598,542	IMPLANT AND METHODS THEREOF FOR TREATMENT OF OCULAR DISORDERS	November 13, 2006	GLAUKO.011C1
12/111,033	SYSTEM FOR TREATING OCULAR DISORDERS AND METHODS THEREOF	April 28, 2008	GLAUKO.011C1C1
12/366,508	SELF-TREPHINING IMPLANT AND METHODS THEREOF FOR TREATMENT OF OCULAR DISORDERS	February 5, 2009	GLAUKO.011C1DV1
12/366,585	OCULAR IMPLANT DELIVERY SYSTEM AND METHODS THEREOF	February 5, 2009	GLAUKO.011C1DV2
10/634,213	DEVICES AND METHODS FOR TREATMENT OF OCULAR DISORDERS	August 5, 2003	GLAUKO.011CP1
11/836,106	DEVICES AND METHODS FOR TREATMENT OF OCULAR DISORDERS	August 8, 2007	GLAUKO.11CP1C1
11/836,112	DEVICES AND METHODS FOR TREATMENT OF OCULAR DISORDERS	August 8, 2007	GLAUKO.11CP1C2
11/084,314	OCULAR DISORDER TREATMENT IMPLANTS WITH MULTIPLE OPENINGS	March 18, 2005	GLAUKO.11CP2CP1
12/246,448	DRUG ELUTING OCULAR IMPLANT WITH ANCHOR AND METHODS THEREOF	October 6, 2008	GLAUKO.11CP3DV1
11/860,785	OCULAR IMPLANT WITH DOUBLE ANCHOR MECHANISM	September 25, 2007	GLAUKO.013C1DV1
11/455,598	IMPLANT DELIVERY SYSTEM AND METHODS THEREOF FOR TREATING OCULAR DISORDERS	June 19, 2006	GLAUKO.017C1
11/455,391	IMPLANT DELIVERY SYSTEM AND METHODS THEREOF FOR TREATING OCULAR DISORDERS	June 19, 2006	GLAUKO.017C2
11/332,746	FLUID INFUSION METHODS FOR OCULAR DISORDER TREATMENT	January 12, 2006	GLAUKO.020C1

Serial Number	Title	Filed	Attorney Docket No.
11/653,815	COMBINED TREATMENT FOR CATARACT AND GLAUCOMA TREATMENT	January 16, 2007	GLAUKO.022C1
10/338,743	OCULAR IMPLANT WITH ANCHORING MECHANISM AND MULTIPLE OUTLETS	December 18, 2008	GLAUKO.035DV1
11/938,238	UVEOSCLERAL SHUNT AND METHODS FOR IMPLANTING SAME	November 9, 2007	GLAUKO.099A

Copies of the applications, and pending claims, including any office actions and allowances, and any publications are available through PAIR. However, if the Examiner so requests, Applicants will be happy to provide the Examiner with copies of any publications, applications, pending claims, office actions, allowances, or any other documents, at any time.

Further, office actions from two of the above-identified patent applications have been listed on Form PTO/SB/08 Equivalent of the Supplemental Information Disclosure Statement submitted herewith. The Examiner's consideration of this Information Disclosure Statement is respectfully requested.

### Conclusion

Applicants respectfully submit that the claims are in condition for allowance in view of the above remarks. Any remarks in support of patentability of one claim, however, should not be imputed to any other claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although amendments may have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Applicants also reserve the right to later contest whether a proper reason exists to combine these references as well as to later present facts and arguments supporting the non-obviousness of the claimed subject matter.

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Applicants have made a good faith effort to respond to the outstanding Office Action. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is cordially invited to contact Applicants' attorney, at the telephone number below, to resolve any such issues promptly. Also, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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